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**IN THE UNITED STATES DISTRICT COURT
FOR THE NORTHERN DISTRICT OF CALIFORNIA
SAN JOSE DIVISION**

AIRWAIR INTERNATIONAL LTD., a United
Kingdom corporation,

Plaintiff,

vs.

VANS, INC., a Delaware corporation; DOES 1-
100, inclusive,

Defendants.

Case No. 12-cv-05060-EJD

**JOINT CASE MANAGEMENT
STATEMENT; [PROPOSED] ORDER**

Complaint Filed: September 28, 2012

Date: February 8, 2013

Time: 10:00 a.m.

Place: Courtroom 4 – 5th Floor

Honorable Edward J. Davila

1 Plaintiff AIRWAIR INTERNATIONAL LTD., a United Kingdom corporation
 2 (“AirWair” or “Plaintiff”) and Defendant VANS, INC., a Delaware corporation (“Vans” or
 3 “Defendant”) have conferred pursuant to Federal Rule of Civil Procedure 26(f). As a result of
 4 that conference, AirWair and Vans submit this joint Case Management Conference (“CMC”) Statement and [Proposed] Order pursuant to Federal Rule of Civil Procedure 26 (f)(2), L. R. 16-
 5 9 and this Court’s Standing Order for All Judges of the Northern District of California dated
 6 July 1, 2011:

7
 8 1. Jurisdiction & Service

9 AirWair contends that this Court has original subject matter jurisdiction under 28 U.S.C.
 10 §§ 1331 and 1338(a) and the Lanham Act (15 U.S.C. § 1121), in that this case arises under the
 11 trademark laws of the United States. AirWair further contends that jurisdiction also arises for the
 12 state law claims herein under 28 U.S.C. Section 1367(a) pursuant to the principles of
 13 supplemental jurisdiction. Defendant Vans denies that subject matter jurisdiction exists for any
 14 of Plaintiff’s claims, and has filed a motion to dismiss, which is set for hearing on March 29,
 15 2013. Vans, however, does not contest either personal jurisdiction or venue before this Court.
 16 At this time, all parties have been served and Plaintiff AirWair does not anticipate naming or
 17 serving any additional parties unless additional facts learned in discovery reveal additional
 18 parties or reasons to add another party (whether currently known or unknown) into the litigation.

19 2. Facts

20 Plaintiff AirWair contends that sometime in 2011 it became aware of shoes being sold
 21 under the VANS trademark in Japan that AirWair alleges illegally incorporated protected trade
 22 dress of AirWair, which trade dress has been registered in the United States with the United
 23 States Patent and Trademark Office (“USPTO”), and which is confusingly similar to AirWair’s
 24 Eclectic line of shoes. The VANS-branded footwear at issue in this case is a line of footwear
 25 called the “Gibson,” which includes various shoe and boot models (the “accused shoes”).
 26 AirWair contends that the accused shoes were sold through the www.vansjapan.com website,
 27 and that such website is owned by and registered to Defendant Vans in the United States. The
 28 accused shoes were also featured in articles by at least two American blogs and publications

1 aimed at American consumers. In January, 2012, AirWair discovered that there were 11,000
 2 pairs of the accused shoes remaining in inventory, and that Defendant's licensee was continuing
 3 to sell the accused shoes. AirWair requested that Vans immediately stop selling the accused
 4 shoes and to either destroy or return to AirWair the remaining inventory of the accused shoes.
 5 AirWair was able to purchase two pairs of the infringing shoes over the Internet from third-party
 6 resellers in July, 2012 and in October of 2012, filed the within suit for infringement against
 7 Vans. AirWair contends that an appreciable number of the shoes were purchased by American
 8 consumers, thereby having a substantial effect on U.S. commerce, and damaging AirWair.
 9 AirWair also contends that Vans's failure to induce the cessation of sales of the accused shoes,
 10 over AirWair's protest, further implicates US commerce.

11 Vans contends that the accused shoes, known as Vans Gibson shoes, were designed and
 12 manufactured by Vans' licensee for sale in Asia, and were clearly identified as VANS brand
 13 shoes. Vans further contends that the Vans Gibson shoes were lawful and did not infringe any
 14 trademark rights of AirWair in the Asian countries where they were being sold or in the United
 15 States. Vans denies that the sale of the Vans Gibson shoes in retail stores in Asia and over a
 16 Japanese website operated and controlled by Vans' Asia licensee (1) had a substantial effect on
 17 commerce in the United States, (2) caused any likelihood of confusion between the Vans and Dr.
 18 Martens brands, (3) caused any likelihood of dilution of the Dr. Martens brand, or (4) caused any
 19 actual damages to AirWair.

20 3. Legal Issues

21 a) Whether AirWair has protectable trade dress that can be enforced against
 22 Vans;

23 b) Whether the Lanham Act may be applied extraterritorially in this case;

24 c) Whether the accused shoes infringe AirWair's trade dress (*i.e.*, whether
 25 there is a likelihood of confusion between AirWair's trade dress and that used on the
 26 accused shoes), either under 15 U.S.C. Section 1125, 15 U.S.C. Section 1114, and/or the
 27 common law;

28 d) Whether Vans is liable as a direct, contributing, or vicarious infringer

under the referenced code sections and common law;

e) Whether AirWair is entitled to damages for any such infringement and, if so, for what amount;

f) Whether AirWair is entitled to injunctive relief for such infringement and, if so, in what form;

g) Whether the accused shoes dilute AirWair's trade dress under 15 U.S.C. Section 1125 or under California State law (Cal. Bus. & Prof. Code Section 14202 and 14247);

h) Whether Vans is liable for dilution of AirWair's trade dress under a direct, contributory, or vicarious theory under the referenced code sections;

i) Whether AirWair is entitled to damages for any such dilution and, if so, for what amount;

j) Whether AirWair is entitled to injunctive relief for such dilution and, if so, in what form;

k) Whether Vans is liable for unfair business practices under California Bus. & Prof. Code Section 17200 and/or under the common law;

l) Whether AirWair is entitled to damages for any such unfair business practices and, if so, for what amount under the referenced code section or common law; and

m) Whether AirWair is entitled to injunctive relief for such unfair business practices and, if so, in what form under the referenced code section or common law.

4. Motions

Vans filed a motion to dismiss the complaint, which is scheduled to be heard on March 29, 2013. The parties have stipulated to a modified briefing schedule, with AirWair's opposition due on February 8, 2013, and Vans' reply due on March 1, 2013. The Court issued an order consistent with that stipulation. Vans also anticipates that it may file a motion for summary judgment on the issues of no likelihood of confusion, no damages, and/or no subject matter jurisdiction. The parties believe there may be discovery disputes requiring law and motion.

1 5. Amendment of Pleadings

2 The parties agree to a cutoff of 60 days after the last responsive pleading is filed by
3 Defendant Vans for adding any additional parties. However, AirWair reserves the right to seek
4 leave of Court to add additional parties after such deadline if, through the discovery process,
5 AirWair learns of currently unknown parties that should be added to this action or of facts that
6 warrant the addition of parties already known to Plaintiff.

7 6. Evidence Preservation

8 Counsel has discussed evidence preservation issues and reviewed the Guidelines Relating
9 to the Discovery of Electronically Stored Information. The parties are aware of their duties to
10 preserve evidence and evidence is being preserved.

11 7. Disclosures

12 The parties intend to comply with the initial disclosure requirements of Fed. R. Civ. P. 26
13 and have agreed to an exchange date of February 6, 2013.

14 8. Discovery

15 The parties do not anticipate that any special exceptions will be required dispensing with
16 the limitations on discovery set forth in Federal Rule of Civil Procedure 26. Depositions will be
17 required on both sides.

18 Defendant Vans has propounded a set of interrogatories, requests for production, and
19 requests for admissions, answers to which are due in late February, 2013. Plaintiff is preparing
20 discovery requests that will be served in due course.

21 9. Class Actions

22 N/A.

23 10. Related Cases

24 None.

25 11. Relief

26 Damages in an amount to be proven at trial; injunctive relief prohibiting the sale of
27 products incorporating the trade dress of AirWair worldwide.

28 ///

12. Settlement and ADR

The parties have informally discussed settlement but have reached no resolution. Vans requests referral to Magistrate Judge Spero for a Settlement Conference. AirWair would prefer private mediation. Regardless of the form of ADR ultimately approved by the Court, the parties believe no fruitful ADR can take place prior to a ruling on Vans' pending motion to dismiss, scheduled to be heard on March 29, 2013, and the completion of initial discovery.

13. Consent to Magistrate Judge For All Purposes

_____ YES X NO

The parties did not consent to have a Magistrate Judge preside over the entire case, including trial.

14. Other References

The parties do not believe the case is suitable for reference to binding arbitration, a special master, or the Judicial Panel on Multidistrict Litigation.

15. Narrowing of Issues

The parties do not believe the issues can be narrowed at this early point in the case.

16. Expedited Trial Procedure

The parties do not believe this case is appropriate for expedited trial procedure. AirWair, in particular, asserts this fact because it anticipates some overseas discovery, which will be time consuming.

17. Scheduling

The parties propose the following discovery and court dates:

Fact Discovery Cutoff: December 31, 2013

Expert Reports: February 28, 2014

Rebuttal Expert Reports: March 31, 2014

Expert Discovery Cut-off: April 30, 2014

Last Date to File Dispositive Motions: May 30, 2014

Final Pretrial Conference Date: August 31, 2014

Trial Date: September 15, 2014

1 18. Trial

2 The parties request a jury trial, which the parties expect will run five to seven court days.

3 19. Disclosure of Non-Party Interested Entities or Persons4 a) Plaintiff filed a Certification of Interested Entities or Persons pursuant to
5 Civil Local Rule 3-16, stating that the following listed persons, associations of persons,
6 firms, partnerships, corporations (including parent corporations) or other entities (i) have
7 a financial interest in the subject matter in controversy or in a party to the proceeding, or
8 (ii) have a non-financial interest in the subject matter or in a party that could be
9 substantially affected by the outcome of this proceeding: R. Griggs Group Ltd., a
10 company organized under the laws of England and Wales.11 b) Defendant has filed a Certification of Interested Entities or Persons
12 pursuant to Civil Local Rule 3-16 stating that the following listed persons, associations
13 of persons, firms, partnerships, corporations (including parent corporations) or other
14 entities (i) have a financial interest in the subject matter in controversy or in a party to
15 the proceeding, or (ii) have a non-financial interest in the subject matter or in a party that
16 could be substantially affected by the outcome of this proceeding: ABC-Mart, Inc.,
17 ABC-Mart Taiwan, Inc., and ABC-Mart Korea, Inc.18 20. Other

19 None.

20 ////

21 **SIGNATURE PAGE TO FOLLOW**

Jointly submitted this 1st day of February, 2013.

Dated: February 1, 2013 By: **HIARING + SMITH, LLP**

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Dated: February 1, 2013 By: **REED SMITH LLP**

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Attorneys for Defendant
VANS, INC.

ATTESTATION OF CONCURRENCE

I, Vijay K. Toke, attest that I am one of the attorneys for Plaintiff AIRWAIR INTERNATIONAL LTD., a United Kingdom corporation, and, as the ECF user and filer of this document, I attest that, pursuant to United States District Court, Northern District of California Civil L.R. 5-1(i)(3), concurrence in the filing of this document has been obtained from Robert N. Phillips, the above signatory.

Dated: February 1, 2013 By: **Vijay K. Toke**

Vijay K. Toke

[PROPOSED] ORDER

The above JOINT CASE MANAGEMENT STATEMENT is approved as the Case Management Order for this case and all parties shall comply with its provisions.

[In addition, the Court makes the further orders stated below:]

IT IS SO ORDERED.

Dated: _____

HONORABLE EDWARD J. DAVILA
UNITED STATES DISTRICT COURT JUDGE